

REQUEST FOR RECONSIDERATION

Reconsideration is respectfully requested. This Request for reconsideration does not include any amendment. Nor does this Request for reconsideration constitute an amendment.

Background

Claims 1-21 are pending. The Office Action ("Action") dated March 20, 2006 included an objection to the drawings. The drawing figures 9 and 10 were objected to because each allegedly contained a minor informality. Applicants on April 26, 2006 filed an amendment to the drawings that included amended figures 9 and 10. The Advisory Action dated May 9, 2006 indicated that the Applicants' amendment to the drawings was denied entry.

Request to have the drawing objection withdrawn

Applicants respectfully submit that "amendments filed after a final rejection, but before or on the date of filing an appeal, complying with objections or requirements as to form *are to be permitted after final action*". MPEP 714.12. Further, "Applicant should be notified, if certain portions of the amendment would be acceptable as . . . complying with objections or requirements as to form, if a separate paper were filed containing only such amendments". MPEP 714.13(III). Also, "In an application in which prosecution on the merits is closed . . . where an amendment is presented curing the noted formal defect . . . the amendment in such a case will be entered . . . as to the formal matter". MPEP 714.20(C).

The Drawing Objection

Figure 9 was objected to because of an alleged informality. Specifically, Figure 9 was objected to for "Failing to comply with 37 CFR 1.84(p)(4) because reference characters '154' and '164' have both been used to designate the same part in figure 9" (Action page 4).

Figure 10 was likewise objected to because of an alleged informality. Specifically, Figure 10 was objected to for "Failing to comply with 37 CFR 1.84(p)(4) because reference characters '94' and '80' have both been used to designate the same part in figure 10" (Action page 4).

37 CFR 1.84(p)(4) reads:

The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts.

Figure 9 complies with 37 CFR 1.84(p)(4)

Applicants respectfully submit that the drawing objection to Figure 9 should be withdrawn because it is legally improper. Applicants respectfully submit that drawing Figure 9 complies with 37 CFR 1.84(p)(4). The reference characters 154 and 164 do not designate the *same* part in Figure 9. Reference character 154 designates the cam. Reference character 164 designates the cam surface. The disclosure (including figure 9) verifies these separate designations. For example, specification page 22, at line 17 indicates that the cam 154 is bounded by the cam surface 164. This is further evidenced by Figures 7 and 10. The cam surface 164 is part of the cam 154. A line pointing to the cam's surface 164 would also be pointing to the cam 154.

Figure 9 is not to be read in a vacuum, but in light of the entire disclosure. Figure 9 is a cross sectional view. One of ordinary skill in the art would understand that reference characters 154 and 164 do not designate the same part in figure 9, as alleged by the Examiner. Thus, the objection to figure 9 is legally improper.

Figure 10 complies with 37 CFR 1.84(p)(4)

Applicants respectfully submit that the drawing objection to Figure 10 should be withdrawn because it is legally improper. Applicants respectfully submit that drawing Figure 10 complies with 37 CFR 1.84(p)(4). The reference characters 94 and 80 do not designate the *same* part in Figure 10. Reference character 94 designates the second outboard portion. Reference character 80 designates the outer bounding surface. The disclosure (including figure 10) verifies these separate designations. For example, the specification is clear that the picking member 72 has an outer bounding surface 80 (e.g., page 17, line 1; Figures 2-3). The specification is also clear that the picking member 72 has a shaft 88 and that three separated cylindrical portions (central portion 90, first outboard portion 92, and second outboard portion 94) are supported on the shaft 88 (e.g., page 19, lines 7-14; Figures 2-3). However, for ease of understanding, figure 10 only shows the picking member 72 with regard to the cylindrical portion 94 (e.g., page 24, lines 11-13). Figure 10 also shows the outer surface of arcuate segment 144 (of the cylindrical portion 94) moved to generally conform with the outer bounding surface 80 of the picking member 72 (e.g., page 26, lines 3-8).

Figure 10 is not to be read in a vacuum, but in light of the entire disclosure. Figure 10 is a cross sectional view. One of ordinary skill in the art would understand that reference characters 94 and 80 do not designate the same part in figure 10, as alleged by the Examiner. Thus, the objection to figure 10 is legally improper.

Additional reasons

Applicants also respectfully traverse the drawing objections on the basis that the application includes at least one process claim. MPEP § 601.01(f) and MPEP § 608.02 make

clear that with recitation of a method claim a drawing is neither necessary for an understanding of the invention nor required. The drawings were filed as a courtesy to the Office. For these additional reasons, Applicants respectfully submit that the drawing objection should be withdrawn.

Request for reconsideration to enter the drawing amendment filed April 26, 2006

The Examiner specifically required the drawings to be amended. The Action (on page 4) stated that "Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action". 37 CFR 1.116(b)(1) authorizes an amendment after final to be made for "canceling claims or complying with any *requirement of form* expressly set forth in a previous Office action".

Applicants, in response to the requirement of form set forth in the Action, filed amended drawings that adopted the Examiner's suggestion. The amended drawings complied with 37 CFR 1.121(d). Applicants respectfully submit that the amended drawings filed April 26, 2006 should be entered.

Request to have the drawing objection held in abeyance

The objection to the drawings is to form only and is not necessary for consideration of the claims. The Examiner (at Action page 4) acknowledged that the drawing objection is based on mere informalities. Furthermore, "Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters". MPEP 714.02. Thus, Applicants request that the drawing objection held in abeyance until allowable subject matter is indicated. 37 CFR 1.111(b).

Request for reconsideration of the rejections

The 35 U.S.C. § 103 rejection of claim 1

The Office admits that Graef does not teach or suggest any recited step. Likewise, Graef appears to teach against the recited invention. Davidson is non analogous art. Davidson is directed to an "electrophotographic printing machine" (col. 1, lines 4-8). How is Davidson analogous to the environment of a "cash dispensing automated banking machine"?

The Action alleges that Davidson's spring (208) constitutes a resilient tab portion. However, the Action is silent regarding Davidson's own differentiation between a spring (208) and a tab (212). The Office also has not explained how Davidson's spring (208) is "on a housing". The Action is silent as to what constitutes the "housing" in Davidson.

Nevertheless, even if it were somehow possible for Davidson's spring (208) to constitute a resilient tab portion as alleged, Davidson still would not teach or suggest the tab/picking shaft first end and drive shaft/picking shaft second end relationships. First, the alleged tab (208) is associated with the *drive* shaft (209), not the alleged *picking* shaft (210) (col. 5, lines 8-9). Where does Davidson show a tab portion at an end of a picking shaft? Second, at best the alleged tab (208) and the drive shaft (209) are each adjacent the *same* end of the picking shaft (210), not at opposed first and second ends. Where does Davidson show both a tab portion at a first end of a picking shaft and a drive shaft at the second end of the picking shaft?

Nor has the Office explained how Graef could be modified to have produced the recited invention, especially without destroying the disclosed utility and operability of the Graef apparatus. An obviousness rejection cannot be based on a combination of features that would result in destroying the utility or advantage of the device taught in Graef. *In re Fine*, 837 F.2d

1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

The attempts to modify Graef are clearly attempts at hindsight reconstruction of Applicants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Applicants' disclosure.

The Office has not established a *prima facie* showing of obviousness. The references, taken alone or in combination, do not teach or suggest all of the recited features, relationships, and steps. Nor would it have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention.

The 35 U.S.C. § 103 rejection of claims 2-6

For reasons of brevity, Applicants' previous remarks regarding the patentability of claim 1 are incorporated herein by reference. The references, taken alone or in combination, do not teach or suggest the recited features, relationships, and steps.

The 35 U.S.C. § 103 rejection of claims 18-21

Claims 18-21 were newly rejected as obvious pursuant to 35 U.S.C. § 103(a) over Graef (US 2004/0094889) in view of Sheng (US 2003/0122298). However, Graef (US 2004/0094889) does not constitute prior art to the recited invention.

This Graef application and the Graef reference (US 2004/0094889) were, at the time the invention was made, owned by, or subject to an obligation of assignment, to the same entity.

The relationship of this Graef application and the Graef reference is a fact which no denial of entry can change. Furthermore, in the Advisory Action dated May 9, 2006 the

Examiner indicted (at box 11) that the Request for Reconsideration filed April 26, 2006 was fully considered. That is, the Examiner has stated on the record that he is aware of this fact.

Subject matter developed by another person which only qualifies as prior art under 35 U.S.C. § 102(e) is disqualified as prior art under 35 U.S.C. § 103(a) where the subject matter and the claimed invention were subject to an obligation of assignment to the same entity at the time the invention was made. 35 U.S.C. § 103(c). MPEP § 706.02(I)(1).

In accordance with 35 U.S.C. § 103(c), Graef cannot preclude patentability of the present invention. Therefore, it is respectfully submitted that Graef is disqualified as prior art in relation to the present invention with regard to 35 U.S.C. § 103(a).

Applicants "may overcome a 35 U.S.C. § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references" (MPEP § 715.02). Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claims 18-21 is legally improper and should be withdrawn.

Because Graef (US 2004/0094889) does not constitute prior art to the recited invention, the rejection of claims 18-21 is without merit. It follows that claims 18-21 are allowable.

Request that the allowance of claims 7-17 and 18-21 be specifically stated on the record

Claims 18-21

As previously discussed, claims 18-21 are allowable. Thus, Applicants respectfully request that the allowance of claims 18-21 be specifically stated on the record.

Claims 7-17

As best understood, claims 7-17 are allowed. MPEP § 707.07(d) makes clear that in order for a claim to be formally rejected on the merits, the ground of rejection must be fully and clearly stated. A proper ground of rejection statement must include an "express reference to a section of 35 U.S.C. in the opening sentence of *each* ground of rejection". That is, the claims being rejected, the word "reject", and the section of 35 U.S.C. being relied upon as the basis for the rejection are to appear in the same sentence. This is evidenced by the form paragraphs from MPEP § 706.02(i), (j), and (m), which are to be used.

Nowhere in the Action are claims 7-17 in a sentence that includes the word "reject" and a reference to a section of 35 U.S.C. Nowhere in the Action are claims 7-17 used in one of the required form paragraphs. It follows that claims 7-17 are not rejected. Thus, they must be viewed as allowed. The allowance of claims 7-17 is appreciated.

Conclusion

Applicants respectfully submit that this application is in condition for allowance.

The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000